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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,141	01/16/2002	Tetsuo Yamaguchi	2870-0177P	3642

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	12/29/2006	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/29/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/046,141

Applicant(s)

YAMAGUCHI, TETSUO

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to the communication on October 2, 2006; claims 1-6, 8-15 are pending; claim 7 has been canceled.
2. The rejection under 35 USC 112 , first paragraph, set forth in the office action on May 2, 2006 is withdrawn in view of the applicants' amendment on October 2, 2005.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (Ito) in view of either JP11-149136 (JP'136) or Adin et al (Adin).

Ito a photothermographic material containing non-photosensitive silver halide, photosensitive silver halide, reducing agent for silver ions and binder and the compound of formula (1) to (3) claimed in the present claimed invention, and the amount thereof is within 1×10^{-6} mol to 1 mol/mol of silver halide. Note to the compound of formula (1) to (3) in column 18 and the amount thereof in column 33, lines 22-25.

The JP'136 discloses a heat-developable material containing non-photosensitive silver halide, photosensitive silver halide, reducing agent for silver ions and binder and the compound exemplified in the present application disclosure which is within the scope of formula (I) claimed in the present invention, and the amount thereof is from 1×10^{-6} mol to 1 mole/mol of silver halide. See the compound in column 1 (or Its English equivalent, US Patent No. 6,177,240, in

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columns 7-24; and in column 26, lines 37-40). This compound is within the scope of formula (I), which contains nitrogen containing heterocyclic compound, and the functional groups such as $-CO_2M$ which is within the scope of A-B of the formula (I). The compound provide photothermographic material high in D_{max} and sensitivity, enhanced enough in contrast, small in photographic performance due to fluctuation of development conditions and superior in effect of restraining dependence on development condition.

Adin discloses a spectrally sensitize within the scope of formula (I) of the claimed invention, and the amount thereof is from 1×10^{-8} to 2×10^{-3} mol per mol of silver in the emulsion layer. The compound is capable of enhancing both intrinsic sensitivity and the spectrally sensitivity of the silver halide emulsion, and the activity of the compound can be easily varied with substituents to control their speed and fog effects in a manner appropriate to the particular silver halide in which they are used. Note to the compound in column 4, especially lines 26-38 and 55-65, and the amount thereof in column 60, lines 5-18.

The teaching in Ito discloses a photothermographic material containing a compound of formula in (iv) of formula (1) to (3). The properties of the compound inherently meets the conditions (i) to (iii) presented in the claimed invention are considered as inherently associated with the compound of formula (1) to (3) of Ito et al. Ito fails to disclose the compound of formula (I) which however has been known and taught in JP'136 and Adin. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the compound taught in JP'136 to provide the photothermographic material with high in D_{max} and sensitivity, enhanced enough in contrast, small in photographic performance due to fluctuation of development conditions and superior in effect of restraining dependence on development

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condition, or the compound taught in Adin in the material taught in Ito enhance both intrinsic sensitivity and the spectrally sensitivity of the silver halide emulsion to provide the invention as claimed.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-6, 7-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,764,816 (Ohzeki) in view of Ito et al (US Patent No. 6,150,084). The compound of group (iv) has been known as nucleating agent and taught in Ito in column 18, compounds (1), (2), (3). It would have been obvious to the worker of ordinary skill in the art at time the invention was made to use the nucleating agent taught in Ito to improve the image contrast of the material claimed in the '816 patent, and thereby provide an invention as claimed.

Response to Arguments

2. Applicant's arguments filed October 2, 2006 have been fully considered but they are not persuasive for the reason set forth in the rejection above and the response to the applicants' argument in the office action on May 2, 2006. The applicants argument presented on October

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2, 2006 is based on the results shown in the Declaration under 37 CFR 1.132 by Tetsuo Yamaguchi on July 8, 2004 wherein the applicants' counsel asserted that the results the use of the compound 95 taught in JP'136 and the compound taught in Ito et al exhibits unexpectedly superior results compared to the cited prior art.

The argument is not persuasive. It is the Examiner's position that the Declaration such as being presented is insufficient to overcome the prima facie obviousness rejection. First, the statement of unexpected results is based on the Counsel's assertion. "Counsel's arguments cannot take place of evidence. In re Greenfield, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978)". Mr. Tetsuo Yamaguchi states in the Declaration that "I believe that no one skilled in the art would have been motivated to select the compounds of the present invention among the various compounds exemplified in Ito '084 and then combine the selected compounds with compounds of formula (I) in order to attain low fog, high Dmax, improved sensitivity and high contrast before the claimed invention was made. I also believe that no one skilled in the art could have predicted that the claimed combination actually produces low fog, high Dmax, improved sensitivity and high contrast, before the claimed invention was made. I trust that the claimed invention is patentable". Mr. Tetsuo Yamaguchi states that he is an inventor of the present application, but does not provide a statement that he considered himself as the that skilled in the art and found that the results presented in the Declaration are unexpected. The interpretation of the results is based on the inventor own opinion, rather than the opinion of an expert in the art. Therefore, the Declaration is not presented by the one having skilled in the art and therefore, the Declaration has a little probative value. Secondly, the results would be expected by the worker of ordinary skill in the art in view of Adin in column 2, lines

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55-60 which discloses that the silver halide emulsion containing the compound taught therein provide increase the sensitivity of the photographic emulsion and does not increase fog beyond acceptable limits; and JP'136 in the abstract which discloses the compound of formula (I) provide a photothermographic material with high in Dmax and sensitivity and enough contrast . There is no significant difference between the samples A-3, A-4 wherein the high amount of the compound C-1 is used. Both samples has same Dmin and similar Dmax. The increase in sensitivity and the Dmin after leaving would have expected by the use of compound of JP'136 or Adin. Third, the results are not commensurate with the scope of the claimed invention. The results presented in the Declaration is related to the use the silver salt of an organic acid containing high silver behenate content and bisphenols reducing agent which are most preferred in the present invention, in Ito et al and in the photographic art; while the scope of silver salt of an organic acid and the reducing agent claimed in the present invention encompasses the scope of non preferred silver salt of an organic acid and reducing agents. There is no evidence showing that the results are derived by the combination of the compound of formula (I) and the second compound of formula (1), (2) or (3) alone. Accordingly,

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tchea 
2006-12-15


Thorl Chea
Primary Examiner
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